

**REMARKS****Interview Summary**

Applicants thank Examiner Sonya D McCall-Shepard for courtesies extended to Applicants' representatives Stephen M. Roylance and Erica Lin during a telephonic interview on March 27, 2009. In particular, the treatment of claims 13-24 in the Restriction Requirement was discussed and an agreement was reached. Applicants acknowledge receipt of an Interview Summary Sheet dated April 1, 2009 and agree with the statements therein.

Claims 1-24 are pending in the application. Claims 1-24 were subject to the Restriction for Requirement.

***Restriction Requirement***

The Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121 and § 372:

- I. Claims 1-11 and 13-14, drawn to a method of manufacturing a semiconductor wafer.
- II. Claims 12 and 15-24, drawn to a method semiconductor wafer.

***Election with Traverse*****Election**

In order to be responsive to the requirement for restrictions, Applicants elect the invention of Group I, including claims 1-11 and 13-14.

**Traverse**

Notwithstanding the election set forth in Group I in order to be responsive to the Restriction Requirement, Applicants respectfully traverse the requirement for restriction.

The Examiner asserts that Invention groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they allegedly lack the same or corresponding special technical features (Office Action, pg 2).

In response, Applicants note that this application is an application filed under 35 U.S.C. § 371 and that unity of invention requirements apply. Applicants submit that the Office has not set forth any rationale as to why the groups of inventions are not so linked as to form a single general inventive concept, nor has the office indicated what it alleges the special technical feature of the groups of inventions to be.

Further, the Examiner is reminded that in determining unity of invention, the criteria set forth in 37 C.F.R. § 1.475 must be considered. Specifically, Applicants note that 37 C.F.R. § 1.475 provides:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Thus, in stating the restriction requirement, the requirement must state why unity of invention is lacking under § 1.475. In the instant situation, the requirement does not refer to § 1.475, and does not indicate that the requirement is proper in view of this rule.

The Examiner concedes that the required restriction is between product and process claims (Office Action, pg. 3). Applicants respectfully note that such a relationship is considered to have unity of invention under 37 C.F.R. § 1.475. The requirement does not discuss 37 C.F.R. § 1.475(b)(1) or § 1.475(b)(3), which permits an international or a national stage application containing claims to different categories of invention to have unity of invention if the claims are drawn only to one of the following combinations of categories including a product and a process specially adapted for the manufacture of said product. Accordingly, the restriction requirement

is deficient because unity of invention as set forth under 35 U.S.C. § 371 and 37 C.F.R. § 1.475 has not been meaningfully addressed. Applicants respectfully remind the Office that pursuant to these rules, when the Office concludes that all of the claims share a "special technical feature," any remaining non-elected claims should be rejoined.

Furthermore, Applicants respectfully submit that the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. The Examiner has not stated that examination of all the claims would pose a burden, much less set forth *any* reasons why examination of the all the restricted groups would be burdensome. The MPEP states that if the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions. (MPEP 803.)

Further, Applicants respectfully submit that the Examiner has omitted the second of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

Due to the aforementioned omission, it is respectfully submitted that the requirement for restriction is improper and, consequently, its withdrawal is respectfully requested. The requirement contends that there is a serious burden because one or more of five reasons apply:

- a) the inventions have acquired a separate status in the art in view of their different classification,
- b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter, c) the inventions require a different field of search, d) the prior art applicable to

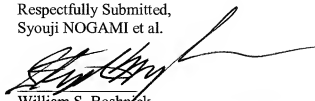
one invention would not likely be applicable to another invention, e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. § 101 and/or 35 U.S.C. § 112, first paragraph.

The Examiner has provided no appropriate statement that the search areas required to examine the invention of each identified group would not overlap into the search areas for examining the invention of the other groups, and *vice versa*. Applicants submit the search for both groups would not appear onerous on the Examiner, such that the search for the combination of features recited in the claims of the above-noted groups, if not totally co-extensive, would appear to have a very substantial degree of overlap.

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicants have elected, with traverse, the invention defined by Group I, claims 1-11 and 13-14 in the event that the Examiner chooses not to reconsider and withdraw the restriction or species requirement.

Should the Examiner have any questions or comments, he is invited to contact the undersigned at the telephone number listed below.

Respectfully Submitted,  
Syouji NOGAMI et al.



William S. Boshnick  
Reg. No. 44,550

April 15, 2009  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191

**Stephen M. Roylance** Reg. No. 31,296  
**Stephen M. Roylance** Reg. No. 31,296